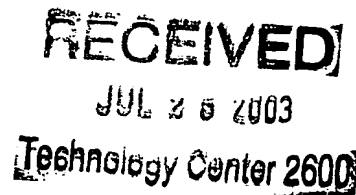


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 045054/0145

#5
S.I
08-04-03

Applicant: Masuyo HORIGUCHI
Title: FOLDABLE PORTABLE CELLULAR PHONE
Serial No. 09/920,966
Filed: August 3, 2001
Examiner: Unknown
Art Unit: 2681



**INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith on Form PTO-SB08 is a list of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any documents which is determined to be a prima facie prior art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The instant Information Disclosure Statement is believed to be filed in accordance with 37 C.F.R. 1.97(b), prior to the mailing date of a first Office Action on the merits (first scenario). If that is not the case, such as in a second scenario in which a first Office Action on the merits has been mailed before the filing of the instant Information Disclosure Statement, then either a certification or fee is required, and a certification is provided below. If neither of the first or second scenarios is the case, such as if a final Office Action or a notice of allowance has been mailed by the PTO (third scenario), then both a certification and fee are required, and in that case a certification is provided below and also the PTO is authorized to obtain the necessary fee to have the instant IDS considered, from Foley & Lardner Deposit Account #19-0741.

CERTIFICATION

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement.

RELEVANCE OF EACH DOCUMENT

A translation of a portion of a Chinese Office Action that issued April 25, 2003 with respect to a counterpart Chinese patent application is provided below.

“(1)

1. Independent claim 1 seeks to protect a foldable portable cellular phone but it fails to express clearly the names and contents of each of the components. Firstly, the “telephone information registering unit” is unclear in meaning and should be amended to be “telephone directory memory” with its description amended accordingly. Secondly, the “switch” is

unclear in meaning and the description to the function it achieves is also unclear; said switch is deduced from the Description and its functions are to search and compare but not to switch, so the use of the word "switch" is inappropriate; meanwhile, according to the Description and Fig. 3, said switch is included in the control section and is closely related to the operation of the control section and the outputting of the incoming sound is controlled by the control section, however, the relationship between said switch and the control section is not described in claim 1. In addition, the condition for outputting an incoming sound corresponding to said transmitter of said incoming call is not described clearly because the statement "through operations of said switch" is not clear enough and the outputting operations of comparing, judging and controlling the incoming sound should be stated clearly therein. Therefore, claim 1 is not clear in protection scope and is not in conformity with the provision of Rule 20, para. one, of the Implementing Regulations of the Patent Law. Even if the applicant overcomes the above-mentioned problems of unclearness, said claim still does not possess inventiveness for the following reasons: reference document 1 (see line 10, page 7 to line 25, page 13 and Figs. 1-4) has disclosed a foldable cellular phone having a body 1 and a cover section 2 with the cover section 2 fixed onto the body 1 and pivoting along body 1 through a hinge 3; the cover section is provided with a display 6 for displaying information; said telephone comprises a control circuit, when said cellular phone receives a call, in order to inform the user about reception of a call, the control circuit informs the user in the alert mode, for example, sound or vibration alert, programmed by the user; if the user does not respond to the call, the control circuit stores reception data like telephone number or ID of the calling party, timestamp, etc. and judges whether signal indicating that the user has opened the foldable telephone is received, if so, the display will display that the user did not respond to the received telephone data information.

Claim 1 differs from reference document 1 in that the telephone of claim 1 further includes a telephone information registering unit and a switch, and adopts alerting sound mode programmed corresponding to the calling party. Reference document 2 (see line 5, col. 2 to line 14, col. 3 and Fig 2-4) has disclosed a pager for receiving a paging signal having a callback-number (equivalent to the telephone

number of the present application), said pager comprises a storage element (equivalent to the telephone information registering unit), a processor (equivalent to the switch of the present application), said storage element is for storing at least one user-programmed call-back number along with data defining at least one corresponding user-programmed special audible alert; when the user receives the paging signal, the processor stores the call-back number of the paging signal received and searches the call-back numbers in the storage element and compares them with the received call-back number; if they are the same, the pager will alert according to the programmed audible alert mode corresponding to the call-back number stored in the storage element so as to enable the user to recognize the calling party who sent the paging information. Therefore, the above-mentioned differential technical feature has been disclosed by reference document 2. Both the pager of reference document 2 and the telephone of claim 1 belong to the mobile communication user terminal device and said differential technical feature plays the same function in reference document 2 and in claim 1, i.e. establishing a database and setting different sound alert modes for different calling parties, and through the received calling information, recognizing the calling party by means of the sound of alert generated by the communication device. Hence, it is obvious for those skilled in the art to obtain the technical solution of claim 1 on the basis of the cellular phone of reference document 1 in combination with the technical measure of recognizing the caller. Consequently, claim 1 does not possess prominent substantive features and notable progress with respect to reference documents 1 and 2 and it does not conform to the provision on inventiveness of Art. 22, para. three of the Patent Law.

2. Claim 3 further defines the telephone of claims 1 and 2. The cellular phone of reference document 1 comprises an open/close detection circuit to detect whether the cover of the telephone is open or close; if the cover is open, the open/close detection circuit outputs detection signal to the control circuit and the received telephone information which is not responded to could be displayed on the display. The detection signal of claim 3 is to make invalid the history information stored in the storage unit of the control section. Therefore, the difference between claim 3 and reference document 1 lies in the effect of control generated by the signal, which is only the result of different designs and is

obvious to those skilled in the art. Hence, when claim 1 which claim 3 refers to does not possess inventiveness, claim 3 does not possess inventiveness with respect to reference documents 1 and 2 and does not conform to the provision on inventiveness of Art. 22, para. three of the Patent Law. Moreover, claim 3 does not refer to the preceding one claim in the alternative only, so it does not conform to the provision of Rule 23, para. two of the Implementing Regulations of the Patent Law.

3. Claim 4 further defines the telephone of claims 1-3 and claims 5 and 6 further define the telephone of claim 1, however, it is the technical measures commonly used by those skilled in the art that the alert of communication devices like a telephone and a pager could be sound and vibration or the combination of both, and the sound alerting means could be either specially set or using the same sound generator with the communication. Therefore, when claims 1 and 3 to which claim 4 refers to do not possess inventiveness, claim 4 does not possess inventiveness with respect to reference documents 1 and 2 and claims 5 and 6 referring to claim 1 also do not possess inventiveness with respect to reference documents 1 and 2; accordingly, said claims do not conform to the provision on inventiveness of Art. 22, para. three of the Patent Law. In addition, the description to the ringer generator in claim 4 is unclear, and amending said claim, the applicant should state first that said telephone further comprises a ringer generator.

(II)

1. The meaning of "through operations of signals" as stated in claim 2 is unclear, the applicant should state specifically the components on which operations are performed and describe clearly each of the operations; the statement "each corresponding to each of operations of said switch performed two or more times to be input to said control section based on control by said control section" is not fluent in wording and unclear in meaning; therefore, the protection scope of claim 2 is unclear and said claim does not conform to the provision of Rule 20, para. one, of the Implementing Regulations of the Patent Law. If the applicant amends said claim to be an independent claim, he should draft said claim according to Figs. 3-5 and the relevant statements of the Description, and describe specifically the operations on the side key 4. The feature of the present

application is that said side key has the function of reproducing and displaying the incoming sound corresponding to the times of incoming for each of the history incoming call. When amending said claim, the applicant should make it clear and complete.

2. The additional technical features of claims 7 and 8 are not fluent in wording and unclear in meaning. In the present application for invention, the names and time information are only information registered in the telephone directory and no other functions of them have been described; therefore, the protection scopes of said claims are unclear and said claims do not conform to the provision of Rule 20, para. one, of the Implementing Regulations of the Patent Law.

In summary, the applicant should re-submit the Claims to overcome the above-mentioned defects. When amending the Claims, each of the parts of the Description shall also be adaptively amended according to the provision of Rule 18 of the Implementing Regulations and the substitute sheets of the technical solution of the Description shall be submitted. The amendments shall conform to the provision of Art. 33 of the Patent Law."

Applicant's statements regarding the Chinese Office Action is based on a partial translation that Applicant's representative obtained. This statement should in no way be considered as an agreement by Applicant with, or an admission of, what is asserted in the Chinese Office Action.

Applicant respectfully request that the listed documents be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

Respectfully submitted,

July 24, 2003
Date

Phillip J. Articola
Phillip J. Articola
Registration No. 38,819

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5300
Facsimile: (202) 672-5399

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449B/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

Date Submitted: July 24, 2003

(Use as many sheets as necessary)

1 of 1

Complete if Known

Application Number	09/920,966
Filing Date	08/03/2001
First Named Inventor	Masuyo HORIGUCHI
Group Art Unit	2681
Examiner Name	Unknown
Attorney Docket Number	045054-0145

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code ² (if known)			
	A1	5,394,140		WONG et al.	02/28/1995	

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Documents	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Office ³	Number ⁴	Kind Code ⁵ (if known)				
	A2	GB	2 339 648			02/02/2000		

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ⁶

RECEIVED
JUL 25 2003
Technology Center 2600

Examiner
SignatureDate
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.